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REMARKS

Reconsideration and allowance are requested. Claims 1 and 4 are amended to make the

term "the file" consistent throughout the claim by removing the term "transcoder". Claim 25 is

amended only to change the term personal digital assistant to computing device. Claims 14 - 16

and 26 - 28 are amended to correct the grammar by removing the term "said". Applicants

request entry of this amendment although we are after final in that it does not introduce new

matter or require further searching. Claims 1 - 31 are pending.

Rejection of Claims 1, 13 and 25 Under Section 103

The Examiner rejects claims 1, 13 and 25 under Section 103 as being obvious in view of

U.S. Pub. No. 2002/0143821 to Jakubowski ("Jakubowski"). Applicant respectfully traverses

this rejection and submits that the present invention is not obvious in view of Jakubowski.

We first turn to claim 1. The Examiner asserts that Jakubowski inherently provides in his

system for determining whether a rule set is stored before using it. Applicant traverses this

analysis and notes that the step determining whether the transcoding proxy server is storing the

file that comprises the annotation rule set is not inherent from the teachings of Jakubowski. In

the "Background of the Invention" section, Jakubowski states in paragraph [0005]:

> A need therefore exists for a technique utilizable for displaying **only** a specific subset of
> the source page content (i.e., site mining). A need also exists for a technique that allows
> the selected content to be transformed or further manipulated before being displayed to
> the end user. In addition, a need exists for a technique suitable for generating an
> expression for uniquely locating or identifying the location of content in a page so that
> the content may be extracted and/or manipulated during the site mining process.
> (emphasis added)

Here he identifies that the need in the art is to "only" display the reduced destination

page. Therefore, as Jakubowski explains throughout his disclosure, his focus is on generating

stylesheets for source web pages and then utilizing those style sheets to only display the

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destination page to the mobile device. There does not appear to be a scenario contemplated by

Jakubowski to not transcode the web page element.

The fact that a certain characteristic <u>may</u> occur in the prior art is not sufficient to

establish the inherency of that characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d

1955, 1957 (Fed. Cir. 1993). To successfully establish inherency, the extrinsic evidence must

make clear that the missing descriptive matter is necessarily present in the thing described in the

reference and that it would be so recognized by persons of ordinary skill. The mere fact that a

certain thing may result from the given set of circumstances is not sufficient. Furthermore, the

Examiner must provide a basis in fact or reasoning that the allegedly inherent characteristic

<u>necessarily flows</u> from the teachings of the prior art. MPEP 2112. With these MPEP teachings

in mind, we urge the Examiner to withdraw the inherency conclusion. Jakubowski clearly set

forth that the need in the art as he identifies it is to only display the subset of information. He

clearly contemplates the existence in each case of the stylesheet for processing source pages. It

does not necessarily flow from his disclosure to include a determination step of whether a file

exists. Indeed, rather than being inherent in Jakubowski, Applicant submits that Jakubowski

teaches away from such as determination by assuming that proxy requests only arrive for source

webpages that have stylesheets. Furthermore, other means may be employed for arriving at the

result of sending an untranscoded web page element. Therefore, the step of determining if a

proxy server is storing a file as is recited in claim 1 is not inherent in Jakubowski.

Applicants agree with the Examiner that Jakubowski fails to teach that if the file is not

stored, the proxy server does not transcode the web page element and transmits the web page

element to the computing device. However, Applicants traverse the Examiner's argument that it

would be obvious in view of Jakubowski not to transcode the webpage element and transmit the

webpage element to the computing device. The Examiner states that this would provide for a

more adaptable system and so forth. Applicants respectfully challenge this reasoning because it

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simply runs counter to the explicit teachings of Jakubowski. The paragraph 5 listed above makes

clear that Jakubowski's purpose and identified need is to "only" display a specific subset of a

source web page to the recipient computing device. When analyzing the prior art, the Examiner

must consider the reference in its entirety (as a whole) including portions that may lead away

from the invention. MPEP 2141.02. In this case, the clear teaching of Jakubowski is that the

need in the art requires only displaying a subset of a web page as a destination page to the

computing device. Applicant submits that because Jakubowski expressly teaches away from

transmitting the web page element without transcoding, the preponderance of the evidence[1] leads

to a conclusion that claim 1 is patentable over Jakubowski.

Therefore, Applicants submit that: (1) determining if the proxy server is storing a file is

not inherent in Jakubowski; and (2) if the proxy server is not storing the file, not transcoding the

web page element and transmitting the web page element to the computing device is not obvious

in view of Jakubowski's express teachings. Claim 1 is patentable and in condition for allowance.

Independent claims 13 and 25 are patentable as well in view of the above arguments.

Rejection of Claims 1 - 2 and 13 - 14 Under Section 103

The Examiner also rejects claims 1 - 2 and 13 - 14 under Section 103 in view of U.S. Pat.

No. 6,704,798 to Mogul ("Mogul"). Applicant traverses this rejection and submits that Mogul

fails to render these claims obvious.

We again turn to claim 1. The Examiner is correct in noting that Mogul fails to teach that

if the file with the annotation rule set is not stored that the web page element is transmitted

without transcoding to the computing device. However, the Examiner states that it would be

obvious that if a particular rule or rule set is not available, i.e., none was created, none apply,

etc., that no formatting or filtering of data will take place. Applicant notes that the Examiner has

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[1] Applicant notes that MPEP 2142 explains that the preponderance of the evidence standard only requires that evidence be more convincing than not that the claimed invention is obvious. In view of Jakubowski's express teachings away from claim 1, the preponderance of the evidence supports patentability.

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broadened the terms of claim 1 beyond its language. Claim 1 requires determining whether the

transcoding proxy server stores the file comprising the annotation rule set. The Examiner asserts

that it would be obvious in view of Mogul to take a step based on if a particular rule or rule set is

not "available, i.e., none was created, none apply, etc.". However, Applicant note that there is a

difference between how the Examiner characterized the limitation and what the claim requires.

Next, Applicant respectfully submits that Mogul does not render obvious the step of

transmitting the untranscoded web page element to the computing device if the proxy server does

not store the file. When the teachings of Mogul are considered for what they would suggest to

one of skill in the art, it would not lead one of skill to conclude that the untranscoded web page

element is sent in this case. For example, there are several scenarios taught by Mogul for

handling what to do if the conversion programs are not stored on the proxy server. In one case,

if the program is not in the program cache, i.e., on the proxy server, then the proxy server

retrieves the program from a remote location in the network. Col. 8, lines 24 - 27. A library

exists on the proxy server that can identify URLs where conversion programs are found on the

Internet when the conversion programs are not stored in the memory of the server. Col. 6, lines

49 - 55; see also col. 9, lines 43 - 46; col. 12, lines 1 - 11. Therefore, a major point of the

teachings of Mogul involve searching a network for the conversion program when none is found

on the proxy server so that conversion may occur. In this regard, Mogul certainly teaches away

from the present invention which recites transmitting an un-transcoded web page element when

no file is stored on the proxy server.

Where Mogul does mention sending a response without conversion, it is based on other

factors. For example, col 8, lines 18 - 24 mentions that the proxy server may determine not to

apply the conversion program. But these factors are based on the client's capabilities, data

transfer issues, quality loss in conversion, bandwidth, and so forth. None of the mentioned

factors relates to a determination of whether the proxy server stores a file or not.

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There are other examples of how Mogul teaches away from the invention. In col. 8, lines 38 - 48, Mogul discusses applying a set of rules to determine if the client device should receive the response. Where the transmission time is long, or the response is unacceptable to the client, the proxy server may replace the response with an error or warning message. In this regard, Mogul again teaches away from the invention by sending such a warning message in place of the response.

This discussion of the various approaches taught by Mogul primarily identifies that one of skill in the art would not consider it obvious in view of these teachings to arrive at the invention of claim 1. In sum, claim 1 is not obvious for at least these reasons: (1) Mogul teaches going to the network to retrieve the conversion program if the program is not stored on the proxy server; and (2) Mogul teaches that if the set of rules is applied, then an error message will replace the response. The preponderance of the evidence would lead away from a conclusion that one of skill in the art would find it obvious in view of Mogul's teachings that if the proxy server did not store the file comprising the annotation rule set, then the proxy server transmitted the un-transcoded web page element.

Therefore, Applicant respectfully submits that claim 1 is patentable and in condition for allowance.

Similarly, claim 2 depends from claim 1 and is patentable for the same reasons set forth above. Claims 13 - 14 are also patentable for the same reasons set forth above.

Each remaining claim to be discussed is rejected either primarily on Mogul or Jakubowski. Therefore, Applicant respectfully submits that the above arguments make clear that the parent claims are patentable as well as claims 3 - 11 and 15 - 31.

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CONCLUSION

Having addressed the rejection of claims 1 - 31, Applicants respectfully submit that the

subject application is in condition for allowance and a Notice to that effect is earnestly solicited.

Respectfully submitted,

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